

REMARKS

Claims 1-20 are pending in this application.

Claims 1-20 have been rejected.

No claims have been allowed.

Claims 1, 11 and 18 have been amended.

Claims 1-20 remain pending in this application.

Reconsideration of Claims 1-20, as amended, is respectfully requested.

I. AMENDMENTS TO THE CLAIMS

In order to clarify the language of the Applicants' claims, the Applicants have amended Claim 1, Claim 11 and Claim 18 to change the words "an application" to the words "an application program." This does not change the meaning of the term "application" as that term is generally known and used in the computer industry. It is well known that the term "application" refers to and means a computer program. The amendments of Claim 1, Claim 11 and Claim 18 are being made for clarification purposes only and do not change the scope of the claimed subject matter.

II. REJECTIONS UNDER 35 U.S.C. § 103

The April 7, 2005 Office Action rejected Claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over United States Patent Application Publication Serial Number US 2001/0018660 A1 to Richard P. Sehr (hereafter "*Sehr*") in view of United States Patent Application Publication Serial

Number US 2003/0163373 A1 to Vlady Cornateanu (hereafter "*Cornateanu*"). The Applicants respectfully traverse the rejections of Claims 1-20 for the reasons set forth below.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable

expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. MPEP § 2142.

The *Sehr* reference does not disclose the concept of downloading a user-interface program. The *Sehr* reference also does not generally disclose the concept of downloading an application program into a virtual ticket device.

With respect to Claim 1, the Examiner stated that “*Sehr* does not explicitly disclose downloading into the virtual ticket device an application for use in connection with the electronic ticket control system but Cornateanu discloses a portable, wireless data storage for receiving, scanning, storing and transmitting data wherein a downloading means is coupled to a computer software executing means for downloading data to another computer or data receiving terminal, said portable, wireless data device comprising means for receiving electronic ticket data and wherein electronic ticket data are sent via an electronic medium (see abstract).” (April 7, 2005 Office Action, Page 4, Lines 3-9).

The Examiner also stated that “It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the software downloading as taught by Cornateanu into the system of *Sehr* because it would provide a method of application for the portable, wireless data storage comprising receiving electronic ticket data wherein ticket data are sent via radio waves,

the Internet, or E-mail and stored in said storage means.” (April 7, 2005 Office Action, Page 4, Lines 10-14).

In order to establish obviousness by combining references or modifying references there must be some teaching or suggestion in the prior art to combine or modify the references. *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed.Cir. 1997) (“It is insufficient to establish obviousness that the separate elements of an invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the references.”); *In re Rouffet*, 149 F.3d 1350, 1355-56, 47 USPQ2d 1453, 1456 (Fed.Cir. 1998) (“When a rejection depends on a combination of prior art references, there must be some teaching, or motivation to combine the references.”)

Evidence of a motivation to combine prior art references must be clear and particular if the trap of “hindsight” is to be avoided. *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed.Cir. 1999) (Evidence of a suggestion, teaching or motivation to combine prior art references must be “clear and particular.” “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’”). *In re Rouffett*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed.Cir. 1998) (“[R]ejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’”)

The Applicants respectfully submit that there is no teaching or suggestion in the prior art or motivation to combine a downloadable user-interface application program with the *Sehr* system. In particular, the Applicants respectfully traverse the Examiner's characterization of the *Cornateanu* reference as teaching "software downloading." Applicants agree that the *Cornateanu* device comprises computer software programs for executing the functions of the *Cornateanu* device. A careful reading of the *Cornateanu* reference, however, reveals that all of the transfers or downloads to and from the *Cornateanu* device involve transfers of data or information and not transfers of application programs.

The *Cornateanu* reference is completely silent concerning any concept of transferring an application program to or from the *Cornateanu* device. An application program is different from "data and information," and the terms are distinguished in the Applicants' specification. For example, refer to Page 21, Lines 2-23 of the specification where downloaded applications such as venue applications 214 are distinguished from downloaded data files such as venue data files 215.

All of the references to "downloading" in the *Sehr* reference and in the *Cornateanu* reference are to downloading of data and information, and not to downloading of application programs. Neither the *Sehr* reference nor the *Cornateanu* reference discloses, suggests or even hints at the concept of downloading application programs to or from a virtual ticket device.

The Examiner stated that "Cornateanu discloses a portable, wireless data storage for receiving, scanning, storing and transmitting data wherein a downloading means is coupled to a computer software executing means for downloading data to another computer or data receiving

terminal, said portable, wireless data device comprising means for receiving electronic ticket data and wherein electronic ticket data are sent via an electronic medium (see abstract).” (April 7, 2005 Office Action, Page 4, Lines 3-9) (Emphasis added). There is no mention in the *Cornateanu* reference of downloading application programs.

For these reasons, the Applicants respectfully submit that the *Cornateanu* reference does not disclose the concept of “software downloading” as suggested by the Examiner. The Applicants respectfully submit that the *Cornateanu* reference cannot be properly combined with the *Sehr* reference. However, even if the two references could be properly combined, the combination would still not disclose, suggest or hint at the Applicants’ invention as claimed in Claim 1 because neither reference teaches the concept of downloading application programs into a virtual ticket device. The concept of downloading application programs into a virtual ticket device comes from the Applicants’ specification.

Further, the Applicants respectfully submit that the alleged motivation to combine the *Cornateanu* reference with the *Sehr* reference presented by the Examiner does not meet the legal requirement to establish a finding of *prima facie* obviousness. The Applicants respectfully submit that the alleged motivation to combine the references is not clear and particular. The Examiner stated that the alleged motivation “to utilize the software downloading as taught by *Cornateanu* into the system of *Sehr*” was “because it would provide a method of application for the portable, wireless data storage comprising receiving electronic ticket data wherein ticket data are sent radio

waves, the Internet, or E-mail and stored in said storage means.” (April 7, 2005 Office Action, Page 4, Lines 10-14) (Emphasis added).

The Applicants respectfully traverse this assertion of the Examiner. The alleged motivation is not “clear and particular.” The use of the words “method of application” is ambiguous. Does the word “application” refer to an external “application program” that is to be added to the *Sehr* system? Does the use of the words “method of application” refer to the concept of applying method steps? The *Sehr* reference is silent concerning the addition of a downloaded user-interface application program to the *Sehr* system. In addition, the *Cornateanu* reference is silent concerning the addition of a downloaded user-interface application program to the *Cornateanu* system. The inherent operation of the handheld terminals of the *Sehr* system or the *Cornateanu* system does not without more provide a “clear and particular” motivation to modify the *Sehr* reference to add a downloadable user interface program to the *Sehr* system. The Applicants respectfully submit that the alleged motivation to modify the *Sehr* reference with the *Cornateanu* reference has been assumed by “hindsight” in light of the existence of the Applicants’ invention.

The Applicants respectfully submit that Claim 1, as amended, is patentable over the *Sehr* reference and over the *Cornateanu* reference, whether taken singly or in combination. The Applicants respectfully request that Claim 1, as amended, be passed to allowance.

Claims 2-12 and Claims 19-20 depend directly or indirectly from amended independent Claim 1 and include the limitations of amended independent Claim 1. Thus, for the reasons described above with regard to Claim 1, the *Sehr* reference and the *Cornateanu* reference do not

teach or suggest all the limitations of Claims 2-12 and Claims 19-20. Therefore, a *prima facie* case of obviousness has not been established for these claims. The Applicants respectfully request that Claims 2-12 and Claims 19-20 be passed to allowance.

Similarly, Claim 13 contains elements that are analogous to the elements of Claim 1. Thus, for the reasons described above with regard to Claim 1, the *Sehr* reference and the *Cornateanu* reference do not teach or suggest all the limitations of Claim 13. Therefore, a *prima facie* case of obviousness has not been established for Claim 13. The Applicants respectfully request that Claim 13 be passed to allowance.

Claims 14-17 depend directly from independent Claim 13 and include the limitations of independent Claim 13. Thus, for the reasons described above with regard to Claim 1, the *Sehr* reference and the *Cornateanu* reference do not teach or suggest all the limitations of Claim 14-17. Therefore, a *prima facie* case of obviousness has not been established for these claims. The Applicants respectfully request that Claims 14-17 be passed to allowance.

With regard to Claim 18, amended independent Claim 18 recites the limitation of downloading into a virtual ticket device an application program for use in connection with an electronic ticket control system. Thus, for the reasons described above with regard to amended Claim 1, the *Sehr* reference and the *Cornateanu* reference do not teach or suggest all the limitations of amended independent Claim 18. Therefore, a *prima facie* case of obviousness has not been established for amended Claim 18. The Applicants respectfully request that amended Claim 18 be passed to allowance.

The Applicants respectfully request that the rejection of Claims 1-20, as amended, under 35 U.S.C. § 103(a) be withdrawn and that Claims 1-20, as amended, be passed to allowance.

III. CONCLUSION

For the reasons given above, the Applicants respectfully request reconsideration and full allowance of all pending claims and that this application be passed to allowance. The Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. The Applicants reserve the right to submit further arguments in support of her above stated position as well as the right to introduce relevant secondary considerations including long-felt but unresolved needs in the industry, failed attempts by others to invent the invention, and the like, should that become necessary.

SUMMARY


If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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